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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,295	08/07/2000	Alfons Nichtl	100564-00025	4590

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Arent Fox Kintner Plotkin & Kahn PLLC  
1050 Connecticut Avenue N W Suite 600  
Washington, DC 20036-5339

EXAMINER

DO, PENSEE T

ART UNIT PAPER NUMBER

1641

DATE MAILED: 12/18/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/633,295

Applicant(s)

NICHTL, ALFONS

Examiner

Pensee T. Do

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE

3 MONTH(S) FROM

THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**DETAILED ACTION**

***Amendment Entry and Pending Claims***

1. The amendment filed on September 10, 2001 has been acknowledged and entered.
2. Claims 17-21 and 23 were canceled. New claims 24-39 are pending.

**Withdrawn Rejection(s)**

3. Rejection under 112, 2<sup>nd</sup> paragraph is withdrawn herein.
4. Rejections under 102 and 103 in the previous office action are withdrawn herein.

***NEW GROUNDS OF REJECTION***

***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this

application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 24, 30, 31 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Liberti et al. (US 5,597,531).

Liberti teaches a coating process comprising coating a wide range of materials (including dextran, proteins, synthetic polypeptides, polymers, detergents, polyethylene glycol and combinations thereof) onto colloidal magnetically responsive particles to obtain stable microagglomerants. The process comprises the following steps:

- (a) forming a liquid mixture of a particulate magnetic starting material and a coating material;

- (b) treating the mixture to subdivide the particles of the magnetic starting material;

- (c ) permitting the coating material to form a coating on the subdivided particles of the magnetic starting material to form stable, resuspendable coated particles;

- (d) recovering the resuspended coated magnetic particles from the liquid mixture. (See col. 4, lines 45-52; claim 1).

Claims 24, 29-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Olsen (US 5,393,658).

Olsen teaches an immunoassay wherein suspected microorganisms (biomolecules) are treated with a detergent solution to expose additional reactive

epitopes of the biomolecule. The detergent treated microorganisms are reacted with specific colloidal gold labeled antibodies directed against specific antigens of the suspected organism being identified. (see col. 2, lines 25-33). Amphoteric (zwitterionic) and nonionic detergents in concentrations ranging from 0.01% to 5% have been found to be useful to perform optimally in extracting membrane antigens and exhibiting minimal interference of the progression of the antibody antigen reaction. (see col. 2, lines 58-70).

***Claim Rejections - 35 U.S.C. § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 25-29, 32, 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liberti et al. (US 5,597,531) further in view of Nichtl et al. (US 5,972,720).

Liberti teaches a coating process comprising coating a wide range of materials (including dextran, proteins, synthetic polypeptides, polymers, detergents, polyethylene glycol and combinations thereof) onto colloidal magnetically responsive particles to obtain stable microagglomerants. The process comprises the following steps:

(a) forming a liquid mixture of a particulate magnetic starting material and a coating material;

(b) treating the mixture to subdivide the particles of the magnetic starting material;

(c ) permitting the coating material to form a coating on the subdivided particles of the magnetic starting material to form stable, resuspendable coated particles;

(d) recovering the resuspended coated magnetic particles from the liquid mixture. (See col. 4, lines 45-52; claim 1).

Liberti also fails to teach an additional stabilizer such as an inert protein or/and polyethylene glycol after loading the colloidal particles and colloidal particles selected from the group consisting of gold, silver, copper, platinum, palladium and mixture thereof.

Nichtl teaches that after the colloidal particles have been loaded with the respective desired biomolecule, it is necessary to stabilize the conjugates. This stabilization minimizes an aggregation of the particles and to saturate the remaining free surfaces accessible to adsorption. In the state of the art inert proteins, e.g. bovine serum albumin, detergents, and polymers such as polyethylene glycol, polyvinylpyrrolidone, polyvinyl alcohol, polyvinyl sulfate, dextran and gelatin are used as stabilizers. Nichtl also teaches a new stabilizer, thiol-substituted polyethylene glycol, which is added to the conjugate of gold particles or metallic particles such as particles of metals, metal oxides, metal

hydroxides, metal compounds or particles coated with metals or metal compounds. The metal particles are selected from the group consisting of gold, silver, copper, platinum, palladium, and mixture thereof. (see col. 1, lines 47-61; col. 2, lines 25-28; col. 2, line 53-col. 3, line 7).

It would have been obvious to one of ordinary skills in the art to add the an inert protein selected among those taught in Nichtl to the conjugate formed by the method of Liberti since Liberti and Nichtl both teach improving the long-term stability of the conjugates and lowering the aggregation or agglomeration tendency in solution. (see Nichtl col. 2, lines 25-36).

### ***Response to Arguments***

Applicant's arguments filed on September 10, 2001 have been fully considered but they are not persuasive.

Applicant argues that Liberti's attempts to solve the problems associated with colloidal instability of magnetite crystals. Specifically, Liberti's particles are stabilized to prevent re-agglomeration. Applicant also states that "the nanoparticles of the present invention are disbursed from the beginning. At no point is there an agglomeration of the particles for colloidal stabilization but improves orientation of the antibodies on the particle surface. It is of no importance whether the detergent is added to the particles, the antibody solution or to a mixture of both. The concentration of the detergent is not critical. Of paramount importance is that it is simply added. Further, inert protein and/or PEG are not added until after the coating of the antibodies. This allows saturation

of the remaining free patches on the particle surface and thus increases long-term stability.” Regarding the 103(a) rejection, applicant argues that because Liberti has a different reason for adding the detergent, it is unclear how Liberti might suggest an optimal detergent concentration for applicant’s claimed invention.

Liberti still meets the requirement of claims 24, 30, 31 and 33 as a 102(e) reference and of claims 25-28, 34-37, 39 as a 103(a) reference because the reference teaches a method for stabilizing conjugates composed of colloidal particles and biomolecules by adding detergent to a solution containing molecules and thereafter loading colloidal particles with the solution. Although, Liberti may have a different reason or purpose of adding the detergent to the colloidal particles, the method of Liberti still comprises a step of adding the detergent on the particles containing biomolecules and the detergent still serves the purpose of stabilizing the conjugate or the microagglomerant. Regarding the 103(a) argument, since the detergent in Liberti was used for the purpose of stabilizing the microagglomerants including the particles and the biomolecule coated thereon, Liberti’s method of adding the detergent to the conjugate would serve the same purpose of the present invention. Thus, it would be obvious to one of ordinary skill in the art to arrive at the optimum concentration of detergent in order to serve the purpose of stabilization.

### ***Conclusion***



Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 703-308-4398. The examiner can normally be reached on Monday-Friday, 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-746-5291 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Pensee T. Do  
Patent Examiner  
12/17/01

  
LONG V. LE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

12/17/01